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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Flynn)   Art Unit: 2651
)
Serial No.: 10/706,254)   Examiner: Tzeng
)
Filed: November 12, 2003)   HSJ920030243US1
)
For: SYSTEM AND METHOD FOR WRITING SERVO)   March 11, 2006
       TRACK IN SEALED HDD)   750 B STREET, Suite 3120
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REPLY BRIEF

Commissioner of Patents and Trademarks

Dear Sir:

This brief responds to the Examiner's Answer dated March 7, 2006. The Answer improperly raises

a new ground of rejection without the requisite approval of the Technology Center Director (changing the

rejections of Claims 7-9 from a "change in size" rejection based on In re Rose to a "determining optimal

value" rejection based on In re Boesch); see MPEP §1207.02 ("If an examiner's answer is believed to contain

a new interpretation *or application of the existing patent law*, the answer, application file, and an explanatory

memorandum should be forwarded to the TC Director").

The Answer responds to Appellant's observation that Hussein does not write bits associated with a

servo pattern by alleging that Claim 1 claims writing data bits associated with a servo pattern, instead of

reciting "writing servo data bits", as if the difference legitimizes the rejection. It does not, as the Answer's

conclusory statement betrays. Specifically, the Answer maintains that because a dictionary defines

"associated" to mean "unite in a relationship", and because, per an unsupported Examiner allegation, writing

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anything on a disk requires knowledge of a servo pattern, then *any* written data can be considered to be "associated with a servo pattern."

Where to begin? (1) First, there is no evidentiary support provided for the unsupported conjecture that *any and all writings* of *each and every data bit* requires servo information. (2) Regardless of the legitimacy of the conjecture, the conferees fail to explain why "obtaining address information from a servo pattern" (in the words of the conferees) meet the proferred dictionary definition of "unite in a relationship". The data bits manifestly are not "united" with the servo pattern in Hussein. If they were, wouldn't the servo pattern be overwritten? In other words, the word games being played by the conferees are internally inconsistent. The dictionary definition being relied on has not been (and cannot seem to be) reconciled with the ensuing analysis in the Answer, collapsing the rationale for the rejection. (3) Plainly, the effect of the word games in (1) and (2) is to amend Claim 1 to erase an entire phrase: "writing data bits ~~associated with a servo pattern~~". This is because the conferees have placed on the record the allegation that each and every writing of any bit whatsoever meets Claim 1, meaning that the phrase "associated with a servo pattern" is superfluous under their claim interpretation. A claim interpretation that renders a claimed element superfluous is rarely if ever correct.

The Answer continues to allege that the references are combinable merely because they are from the same field of endeavor. But being from the same field of endeavor is at most a threshold test for combining references (i.e., they are analogous). What remains missing is any indication that the conferees understand how to make a *prima facie* case of obviousness in accordance with the law. What is required is a suggestion to combine either in the references or the general knowledge in the art, yet all the Answer can muster is some vague mutterings about "lowering costs" by using an internal head rather than an external servo writer

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without ever pointing to where that suggestion exists in the prior art (as opposed to page 2 of the present specification) or explaining why in fact the proferred "suggestion" is indeed correct in the first place in the context of the prior art, of which the present specification is not a part.

The Answer admits that the "cost" rationale is what is being relied on, and then complains that this really is in the prior art, and "please refer to the Office Action mailed on 12/22/05 for evidence." The only "evidence" in the last Office Action is that the cost rationale indeed has been relied on - but in a vacuum, without prior art support. No "evidence" exists anywhere on the record that the references, as opposed to a guessing examiner looking at things in hindsight, yield the proferred motivation to combine.

Relative to Claim 6 Appellant is grateful for the admission in the Office Action that indeed, Hussein is not directed to servo pattern writing at all, page 15 of the Answer, first full paragraph.
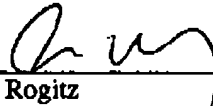
As stated above, the Answer leaps from reliance on Rose to reliance on Boesch to reject Claims 7-9. Apart from the issue of being a new ground of rejection rendered illegitimate by not having been vetted by the TCD, this rejection is even worse than the one predicated on Rose. It relies on a single legal conclusion unsupported by any semblance of fact finding, namely, that the specific write control bit limitations recited in the claims being rejected are "akin" to optimizing values. Appellant has heretofore been unaware of the "akin" test of patentability. Being a novel approach, Appellant suggests that the record might have been further developed regarding why certain bit limitations are "akin" to mere value optimization, apart from the conferees simply decreeing that it is so.

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